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Docket 16952CON1DIV5CIP1

1654
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: AOKI, et al.,) Examiner: Anish Gupta
Serial Number: 10/008,722) Art Unit: 1654
Filed: December 6, 2001) Confirmation No. 5741
For: METHOD FOR TREATING A)
MUCUS SECRETION) Irvine, California

TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450.

Dear Sir:

Please find enclosed with regard to the above-identified pending U.S. patent application: (1) a 4 page response to the October 2, 2003 office action in the above-identified patent application; (2) this 2 page Transmittal Letter; and; (3) a return postcard.

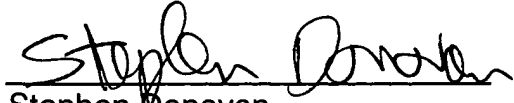
Applicants petition for a one month extension of time to respond to the office action.

CLAIMS AS FILED

	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
Total Claims	16	16	= 0 x	\$18.00	= \$0.00
Independent Claims	04	04	= 0 x	\$86.00	= \$0.00
If application has been amended to contain multiple dependent claim(s), then add			0	\$290.00	= \$0.00
Time Extension Fees:			1 month		= \$110.00
Terminal Disclaimer Fee:			0 x	\$110.00	= \$0.00
Request for Continued Examination (RCE)			0	\$770.00	= \$0.00
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT					\$110.00

The Commissioner is hereby authorized to charge any fees required or necessary for the filing, processing or entering of this paper or any of the enclosed papers (including for the requested one month extension of time), and to refund any overpayment, to deposit account 01-0885.

Respectfully submitted,



Stephen Donovan
Registration Number 33,433

Date: January 14, 2004

Please direct all inquiries and correspondence to:

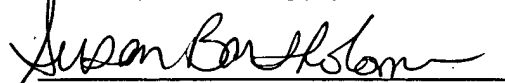
Stephen Donovan
Allergan, Inc.
2525 Dupont Drive, T2-7H
Irvine, California 92612
Telephone: 714 246 4026
Fax: 714 246 4249

CERTIFICATE OF EXPRESS MAILING UNDER 37 C.F.R. §1.10

I hereby certify that this Transmittal Letter and Response to Office Action and the documents referred to as enclosed therein are being deposited with the United States Postal Service on this date **January 14, 2004** in an envelope as "Express Mail Post Office to Addressee" Mailing Label number **EV193721283US** addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Susan Bartholomew

Name of person mailing paper



Signature of person signing paper

Date: January 14, 2004

The Office Action

The October 2, 2003 Office Action rejected claims 1-16 on the grounds of estoppel under 37 C.F.R. §1.658(c).

In the present application applicants received an October 7, 2003 Office Action from the same examiner and the October 7th, 2003 Office Action was responded to on October 14th, 2003.

Hence as it appears that the October 2, 2003 office action was superceded by the October 7, 2003 Office Action, applicants believe that the October 2, 2003 Office Action is moot and does not require a response.

In the alternative, respectfully, the rejection is in error and should be withdrawn.

The Office Action correctly summarizes the outcome of the interference, at the top of page 2 of the Office Action.

Thus the interference concluded, *inter alia*, that the applicants of a parent application of the present patent application were not entitled to the subject matter of Count 3 (treatment of rhinorrhea subject matter).

The Office Action states (on page 3) that "Applicants have copied the claims of Sanders et al (U.S. patent 5,766,605, copy enclosed) and attempting to provoke interference under 1.607(c)." Respectfully, this is not correct. A comparison of the claims pending in the present patent application with the claims in the Sanders '605 patent shows that the claims in this application are not copied from the Sander's '605 patent. Additionally, the purpose of the present patent application is not to provoke an interference with the Sanders '605 patent. The purpose of the present patent application (all claims) is to

obtain a patent for use of a botulinum toxin to treat a non-rhinorrhea mucus secretion.

The Office Action further states that the subject matter claimed in the present patent application could have been brought before the Board in the interference - by the filing by the applicants with the Board of a motion under 37 C.F.R. § 1.633(c) to redefine the interfering subject matter.

The Office Action also states that the subject matter of the claims in the present patent application are similar to the subject matter of Count 3 in the interference and could have been the basis for one or more additional counts wherein the mucus secretion is not a symptom of rhinorrhea.

The Office Action concludes that applicants are estopped from seeking to patent the subject matter of the claims in the present patent application, because a timely Rule 1.633(c) motion seeking to add a further count to the now concluded interference directed to treatment of a mucus secretion which is not a symptom of rhinorrhea, was not filed with the Board.

Respectfully, as explained below, the rejection is in error because the Rule 1.633(c) motion suggested by the Office Action could not have been filed with the Board, and the applicants are therefore not estopped (after the conclusion of the interference) from seeking to patent the subject matter of the claims in the present patent application.


The count which the Office Action indicates should have been filed would have been a count directed to the treatment of a mucus secretion which is not a symptom of rhinorrhea. Count 3 in the interference was expressly limited by the Board to rhinorrhea subject matter. Page 11, lines 22-33 of the present application explains the multiple differences between a treatment of rhinorrhea (count 3) and a treatment of a non-rhinorrhea mucus secretion (the present

application). Essentially, rhinorrhea is a particular and specialized type of mucus secretion and the Sanders '605 patent (copy attached) does not appear to disclose, claim or suggest treatment of any non-rhinorrhea mucus secretions.

In these circumstances a hypothetical count directed to treatment of a non-rhinorrhea mucus secretion would not have been fairly within the subject matter of the interference or of the counts pending in the now concluded interference. Hence, a motion to add a count directed to treatment of a non-rhinorrhea mucus secretion would have been improper and/or could have been expected to have been denied by the Board as not related to the subject matter of the interference (treatment of sweat and treatment of rhinorrhea). For these reasons the rejection should be withdrawn.

Allowance of claims 1-16 is requested.

Respectfully submitted,


Stephen Donovan
Registration Number 33,433

Date: January 14, 2004

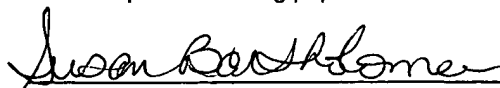
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